



UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/676,248 Confirmation No. : 1133
First Named Inventor : Wilfried Andreas MAESTLE
Filed : September 29, 2000
TC/A.U. : 3624
Examiner : Charles Kyle

Docket No. : 038659.49088
Customer No. : 23911

Title : Machine-Implementable Project Finance Analysis
and Negotiating Tool Software, Method and System

PRE-APPEAL REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being accompanied by a Notice of Appeal and is specifically addressed to the rejection of claims independent claim 49 and dependent claims 51-53, 55-56, 60-61, 63, 66-69, 73-74, 75-77 and 80 as unpatentable over Belcsak (US 2005/0182709) in view of King (US 5,704,045). The rejections under 35 USC 112 and under provisional double patenting have been addressed by the Amendment filed February 13, 2006 which has been indicated as entered and overcoming the 112 rejection and the double patenting rejected. This indication was given by the Examiner in a brief telephone conversation of earlier today (the end of the six month date for response).

Claim 49 is as follows with italics added for purposes of this request for reconsideration.

49. A method for implementing a machine-readable financial simulation computer program product for creating a project preparation, negotiating and testing environment using ***project finance tools***, comprising:

installing the program which is contained as computer readable code on a computer usable medium for generating financial statements, financial data, charts, graphs and reports using ***the project finance tools providing limited recourse including debt service reserve accounts, stand-by loans and risk sharing*** with suppliers and off-takers in a computer;

entry and editing of data representative of multiple contracts and multiple capital expenditure categories;

selecting a desired loan financing time horizon;

setting a percentage of a capital expenditure time series to be financed; and

generating a loan disbursement time series independent of changes in capital expenditures and exchange rates based on an earlier automatically generated disbursement time series.

The application of Belcsak creates a Computer Aided Design-like financial modeling environment that has an "instrument" feature. Instruments are kept in a library and can be accessed by users. Such a library could (but did not at the time of disclosure) contain limited recourse instruments. In the opinion of the examiner it would be easy to create such instruments and integrate them into the Belcsak's invention. Further, Belcsak's tool does not generate financial statements (that is the essence of the project finance modeling exercise).

Applicant submits that it is doubtful that, even if Belcsak's tool would be enhanced by financial statements and limited recourse tools, it would find any acceptance because the system does not provide the transparency of a spreadsheet program that is required by parties to a project finance deal.

The final rejection indicated that "Blcsak does not specifically disclose inclusion of limited recourse including the recited debt service reserve accounts and risk sharing features". These are claimed features in italics above in claim

49. The Examiner concludes that it would have been obvious to modify Belcsak with the "limited recourse tool of King because this would provide elements to reduce risk associated with simulated loans."

However, Applicant submits that the King patent does not describe *limited recourse tools*. In fact he describes an innovative way of organizing an insurance business and ensuring that such an insurance exchange/entity can fulfill its obligations. It allows the insurance exchange/entity to accept risks and allocate capital to statutory reserve accounts. ***This is fundamentally different form the limited recourse instruments used in project finance and does not describe debt service reserve accounts as used in project finance models, as claimed in claim 49.***

The above discussion provides a reason why a project finance model of Belcsak would not likely have financial statements and limited recourse tools(it would be doubtful that it would find any acceptance because the system does not provide the transparency of a spreadsheet program that is required by parties to a project finance deal of the type of Belcsak). Additionally King does not have a showing of *limited recourse instruments used in project finance and does not describe debt service reserve accounts as used in project finance models, as claimed in claim 49*. Therefore, even assuming for purposes of argument, that the references were combined, the claimed invention does not result. Additionally there are significant reasons, discussed above, why any attempt to combine the reference would not be obvious to one skilled in the art. Included in these reasons are lack of compatability of the references, lack of

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claimed subject matter in King which was acknowledged as missing from Belcsak, and an inherent disadvantage in modifying Belcsak reference in the required manner to meet the limitations of claim 49.

The dependant claims contain further distinguishing features but they each contain the limitations of Claim 49 which is sufficient to overcome the rejection.

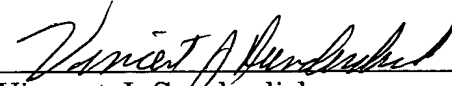
Thus, applicant contends that the King and Belcsak references do not make out a proper, *prima facie* case of obviousness. If there are any questions regarding this Request for Review or the application in general, a telephone call to the undersigned at (202) 624-2838 would be appreciated since this should expedite the prosecution of the application for all concerned.

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If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #038659.49088).

Respectfully submitted,

March 13, 2006



Vincent J. Sunderdick
Registration No. 29,004

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
VJS:lf